

REMARKS

Claims 1-15 are present.

Claims 1-15 are rejected.

Rejections Under 35 USC 103(a)

Claims 1-3 and 7-9 are rejected under 35 USC 103(a) as being unpatentable over Lee et al. (W/O 2004/032566A1) in view of Kim et al. (W/O 2002/19759 A1). Claims 1, 2 and 7 have been amended to more particularly point out the claimed invention. Claim 1 is directed toward a portable telephone having a concave portion therein larger than a bone conduction device that is positioned therein where a cushioning material forms a gap between the housing and the bone conduction device and positions the vibration surface of the bone conduction device from the housing. The Lee '566 publication teaches a bone conduction device positioned in a concave portion of the housing. The Lee '566 publication does not teach either a gap or a cushioning device between the bone conduction device and the housing of the portable phone. The Lee '566 publication shows the bone conduction device contacting the walls of the concave portion of the housing.

The Kim '759 publication teaches cushioning members 60a and 60b surrounding vibrator device 50. The Kim '759 publication is silent regarding a gap being formed by the cushioning device between the bone conduction device and the concave portion of the housing.

Furthermore, the Kim '759 publication teaches away from applicant's claim 1 by teaching that cushioning member 60a covers the diaphragm 56b (vibration surface) of the bone conduction surface. The Kim '759 publication teaches on page 9, lines 12-13 that "the output of the

vibrator 50 varies according to the thicknesses of the cushion members 60a and 60b.”

(Emphasis added) This teaches against exposing the vibration surface of the bone conducting device when using cushion members. The Kim ‘759 patent also further teaches away from the claimed positioning of the cushioning device on page 9, lines 9-11 that “cushion members 60a and 60b contact directly a human body, especially a head, and control the vibrating characteristics of the vibrator 50.” (Emphasis added) The cushioning devices are taught specifically to be arranged opposite as required in the claims and thus is considered to teach away from the claimed invention. The combination of the Lee ‘566 and the Kim ‘759 publications fails to form a prime facie case of obviousness for failing to teach each and every element of claim 1. The cited combination does not teach a gap being formed by the cushioning element from the housing. Furthermore, the Kim ‘759 publication teaches away from having the vibration surface exposed as displayed by the quoted passage. Respectfully, the obviousness rejection of independent claim 1 should reconsidered and removed in view of the teaching of the references.

Independent claim 2 and dependent claim 3 are directed toward a portable phone having a through-hole portion and a cushioning portion disposed between the inner surface of the through-hole portion and the bone conducting device. The Examiner purports that the Lee ‘566 publication teaches claim 2 by copying the claim and implying that all elements are taught. However, the Lee ‘566 publication is silent regarding a telephone having a through hole portion configured to be larger than the bone conduction device and the Examiner admits it is also silent regarding having a material between the device and the through-hole.

The Examiner cites the Kim ‘759 publication to address the shortcomings of the Lee ‘566

publication, but it fails to teach either a through-hole in a phone housing or a cushioning device taught to be positioned between the bone conducting device and the inside of the through-hole. The Kim '759 patent teaches away from the claimed positioning of the cushioning device on page 9, lines 9-11 that "*cushion members 60a and 60b contact directly a human body, especially a head, and control the vibrating characteristics of the vibrator 50.*" (Emphasis added) The cushioning devices are taught specifically to be arranged opposite as required in the claims and thus is considered to teach away from the claimed invention. Regarding the Examiner's assertion that both opposite services of the bone conduction device are taught at "(Lee et al. Figure 1, Figure 5, page 10 lines 23-25, page 11 lines 1-5, page 11 lines 9-17; Kim et al - page 9 lines 3-13)," but the applicant found **no related teaching** of either reference of the cited subject matter. A prime facie case of obviousness of claims 2 and 3 have not been made because each and every element of the claims have not been taught as arranged by the cited references. The applicant respectfully requests reconsideration and removal of the obviousness rejection of claims 2 and 3.

Regarding independent claim 7 and dependent claims 8-9 the claims require a housing having a device installation opening to accept a resilient container portion having the bone conduction device positioned within and a fixing portion to attach the container to the opening. The Examiner correctly identifies that the Lee '566 publication fails to teach a device holder made of resilient material having a container portion and a fixing portion to hold the bone conduction device therein. The Examiner purports that the Kim '759 publication teaches a device holder made of resilient material and the holder carries a bone conducting device therein and a fixing portion mounted on inner surface of a main body of the telephone. The Examiner's

alleged support for the teaching of the Kim '759 publication comes from “(Figure 2, Figure 3, page 6 lines 28-32, and page 7 lines 1-26),” but the cited passages and Figures are silent regarding the holder being made of a resilient material and a fixing portion. Furthermore, figures 2 and 3 is the bone conduction device and not the container to hold the bone conduction device as alleged by the Examiner. Therefore a prime facie case of obviousness of claims 7-9 is not taught by the cited combination because the resilient container and a fixing device for the bone conduction device is not even taught. The Applicant respectfully requests reconsideration and removal of the obviousness rejection of claims 7-9 and allowance of the claims.

Claims 4-5, and 10-12 are rejected under 35 USC 103(a) as being unpatentable over Lee et al. (W/O 2004/032566A1) in view of Kim et al. (W/O 2002/19759 A1), and further in view of Mizuta et al. (US Application Publication 2003/0064758A1). Claims 4-5 and 10-12 depends upon allowable claim 1 for the reasons stated previously above. The Mizuta '758 publication fails to address the previously discussed deficiencies teaching each and every element of independent claim 1. The Mizuta '758 publication fails to address the formation of a gap and the positioning of the cushioning material. The applicant respectfully requests reconsideration and removal of the obviousness rejection of claims 4-5 and 10.

Claims 11 and 12 depend from independent claim 2, which is allowable for the reasons discussed above over a combination of the Lee '566 publication in view of the Kim '759 publication. The Mizuta '758 publication fails to address the positioning of the cushioning material or the presence of a through-hole. The applicant respectfully requests reconsideration and removal of the obviousness rejections of claims 11 and 12 for failing to teach each and every element of the claims.

Claims 6 and 13-15 are rejected under 35 USC 103(a) as being unpatentable over Lee et al. (WO 2004/032566 A1) in view of Kim et al. (WO 2002/19759 A1), and further in view of Kaneko (U.S. Patent Application Publication 2003/0162560 A1). Claims 6 and 13 depend from independent claim 1, which as discussed above is allowable over a combination of the Lee '566 publication in view of the Kim '759 publication for failing to teach a gap or the claimed position of the cushioning material. The Kaneko '560 publication fails to teach the claimed gap or the positioning of the cushioning material as claimed. Applicant therefore respectfully requests reconsideration and removal of the obviousness rejection of claims 6 and 13, which depends from claim 1.

Claim 14 and 15 depends upon independent claim 2, which as discussed above is allowable over a combination of the Lee '566 publication in view of the Kim '759 publication for failing to teach a through-hole and the positioning of the cushioning material as claimed. The Kaneko '560 publication fails to teach the through-hole or the positioning of the cushioning material as claimed. Applicant therefore respectfully requests reconsideration and removal of the obviousness rejection of claims 14 and 15, which depends from claim 2.

CONCLUSION

Favorable action constituting allowance of claims 1-15 is solicited. A one-month extension of time is required and may be charged to deposit account 19-0153 or any additional required extension fees. The applicant requests that the Examiner contacts our office if there are any questions or to advance the application to allowance.

Respectfully submitted,

Date: 30JUL07

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